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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194188
Party	Defendant Sprinkles Cupcakes, Inc.
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Attachments	Sprinkles' OPP. Mot. Compel .pdf (25 pages)(745504 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Soft Serve, Inc. d/b/a Sprinkles,

Opposer,

v.

Sprinkles Cupcakes, Inc.,

Applicant.

Opposition No: 91194188

**APPLICANT SPRINKLES CUPCAKES' OPPOSITION
TO OPPOSER'S MOTION TO COMPEL**

I. INTRODUCTION

Applicant Sprinkles Cupcakes, Inc. ("Sprinkles") has rights in the SPRINKLES trademark for ice cream and retail stores offering ice cream that date back to 1985. Opposer Soft Serve, Inc. ("Opposer" or "Soft Serve") claims to have adopted the name "Sprinkles" in April 2002.¹ Despite its later priority date, Soft Serve has filed this opposition (and seven other proceedings before the Board) seeking an order denying registration of Sprinkles' mark.

In connection with its claims, Soft Serve has served numerous onerous and overreaching discovery requests. Nevertheless, Sprinkles has been forthcoming throughout the discovery process and has responded virtually completely to such requests. Sprinkles has responded to interrogatories and has produced nearly 2,000 pages of documents in three productions. On December 30, 2010, Sprinkles provided privilege and redaction logs to Soft Serve (Soft Serve has yet to provide such logs to Sprinkles).

¹ Sprinkles disputes this first use date, as it is supported only by a bald assertion in Opposer's interrogatory responses, and Opposer has not submitted any documents that would support this first use date; indeed, the documents indicate that Opposer's soft serve restaurant changed its name from I CAN'T BELIEVE IT'S YOGURT to SPRINKLES in December 2002 at the earliest, after Sprinkles' licensee had filed a federal application for the SPRINKLES OF PALM BEACH mark.

The vast majority of issues raised in the present Motion to Compel are moot (and many have always been moot), as Sprinkles has provided the documents or information requested, and has identified any materials withheld on privilege grounds. The only remaining issues are: whether Soft Serve is somehow entitled to production of all documents (including all opinions of counsel) protected by the attorney-client privilege and work product doctrine, whether a representative sampling of Sprinkles uses of the mark and Sprinkles advertising and promotion efforts (comprising hundreds of pages of documents) are sufficient when a full production of these materials would be overly burdensome, and whether Soft Serve is entitled to further responses to two requests that Sprinkles has objected to on the basis of relevance, among other grounds.

As discussed in detail below with respect to each request identified in the Motion, the Board should deny Soft Serve's Motion in its entirety, because (a) Soft Serve's request for waiver of privilege is outlandish and must be rejected, (b) for the vast majority of individual requests called out in the Motion, Sprinkles has produced or provided all documents and information in its possession, and Soft Serve has no reason for questioning the full production, (c) for the two requests where Sprinkles has produced a representative sampling of documents, such a production is commonplace and appropriate, and (d) for the two requests where there is a dispute between the parties, Sprinkles has properly objected that the requests are irrelevant and not likely to lead to the discovery of admissible evidence.

II. BACKGROUND

A. The Parties

Sprinkles is a well-known cupcake bakery with retail stores selling cupcakes in eight locations across the U.S. and a Sprinkles-branded cupcake mix available at Williams-Sonoma stores across North America. Sprinkles has been featured in *The Oprah Winfrey Show*, *Good Morning America*, *The Food Network*, *Access Hollywood* and *Entertainment Tonight*, as well as in *The New York Times*, *Los Angeles Times*, *Bon Appetit*, *Food & Wine*, *Travel & Leisure* and *InStyle*. Sprinkles adopted the SPRINKLES and SPRINKLES CUPCAKES marks for bakery goods and

services in 2004. Sprinkles has registered its SPRINKLES and SPRINKLES CUPCAKES marks in the U.S. and around the world.

In 2009, Sprinkles acquired the SPRINKLES PALM BEACH and SPRINKLES PALM BEACH and Design trademarks for ice cream and retail store services featuring ice cream. Use of the SPRINKLES PALM BEACH trademark began in Palm Beach in 1985, and the business received national press attention (including in Washington, DC, where Opposer claims to have rights) in the 1990s. The SPRINKLES OF PALM BEACH registration (Reg. No. 2938800) was filed on November 13, 2002, and registered on April 5, 2005. Sprinkles has licensed use of the marks, and Sprinkles' licensee continues use of the mark in connection with an ice cream shop in Palm Beach, Florida.

Opposer is a soft serve ice cream and yogurt shop in Potomac, Maryland. Soft Serve claims it first used the SPRINKLES trademark in April 2002, though it has not produced any documents to substantiate this date.

B. The TTAB Proceedings and Discovery

Sprinkles filed Application Serial No. 77/770541 for SPRINKLES for "Ice cream; frozen yogurt; candy; sweets; cupcake mixes; ice cream sundaes, sherbets, ices, sorbets, milk shakes" in Class 30. The application was approved and published, and Soft Serve opposed it on March 12, 2010. Soft Serve later opposed six other applications of Sprinkles, and has also sought cancellation of Sprinkles' registration for SPRINKLES for bakery goods and related retail services. (Cancellation No. 92053109).

The present opposition proceeding is stayed pending the disposition of the present motion. Sprinkles intends to file a motion requesting a stay of all related proceedings pending the disposition of this Motion as well.²

² Several months ago, Opposer requested that all discovery in one action be available for use in the other Sprinkles-related actions pending before the TTAB. After clarifying Opposer's request, Sprinkles agreed to this arrangement. Therefore, because this Motion will affect all eight proceedings, Sprinkles submits that all proceedings should be stayed while the Motion is pending. On December 27, 2010, Sprinkles contacted counsel for Soft Serve to ask whether Soft Serve would consent to the motion, and has followed up on the request. This week counsel reported that Soft Serve is still considering whether it will consent. See Declaration of Hollis Beth Hire ("Hire Decl."), ¶ 2.

Soft Serve served discovery requests on May 28, 2010, and Sprinkles served timely responses with detailed interrogatory responses and hundreds of pages of documents. Sprinkles has since supplemented the production of documents twice, bringing the production to nearly 2000 pages of documents. *See* Hire Decl., ¶ 3, Exh. 1. Sprinkles has also provided redaction and privilege logs. *See* Hire Decl., ¶ 4, Exh. 2.

Sprinkles served discovery requests on June 11, 2010. Soft Serve responded on August 10, 2010 with meager responses to interrogatories and with only 173 pages of documents. Soft Serve objected on the basis of privilege in response to multiple requests. Though Sprinkles requested a privilege log in its letter of September 30 (“September 30 Letter,” attached to Soft Serve’s Motion), Soft Serve has not provided one. *See* Hire Decl., ¶ 5.

III. ARGUMENT

A. Attorney-Client Privilege and Work Product Doctrine Objections Are Reasonable and Valid.

The primary thrust of this Motion is a blasé and inappropriate request for a serious sanction: waiver of privilege for all of Sprinkles’ documents and information. Soft Serve bases this request on the bald assertion that Sprinkles “failed to provide any supporting basis for” the assertion of privilege, *see* Motion at 1. However, Sprinkles has provided the supporting basis for its objections multiple times. In its September 30 Letter, Sprinkles explained:: “As we expect is the case with Soft Serve as well, to the extent that any documents were redacted or withheld, they concerned attorney-client communications or notes by counsel, which are protected by the work product doctrine.” September 30 letter, at 2. Sprinkles withheld conservatively; the only (arguably) responsive documents not included its production (and information withheld from interrogatory responses) concern communications between the proprietor or other employees of Sprinkles, on the one hand, and attorneys at Wilson Sonsini Goodrich & Rosati, Sprinkles’ outside counsel, on the other. The communications concern legal advice to Sprinkles. There is no question that attorney-client privilege applies to these communications.

Though Sprinkles submits that the explanation in its September 30 letter does provide the required substantiation of privilege for the type of documents withheld, the matter is moot because Sprinkles later provided a privilege log, detailing each communication withheld on the basis of privilege. *See* Hire Decl., ¶ 4, Exh. 2. When not unduly burdensome, Sprinkles identified the sender, recipient, date, and substance of each communication (i.e., “advice regarding the instant dispute”).³

It is black letter law that parties are not entitled to discovery of privileged materials. *See, e.g.,* TBMP § 402.02 (“[I]nformation protected by the attorney-client privilege is not discoverable unless the privilege has been waived.”). It is equally well-established that waiver of privilege is a serious sanction, appropriate only in egregious cases. “Waiver of a privilege is a serious sanction most suitable for cases of unjustified delay, inexcusable conduct, and bad faith.” *United States v. Philip Morris Inc.*, 347 F.3d 951, 954 (2003). Waiver is not even an automatic result of any technical discovery misstep; even when a party fails to respond to discovery *at all*, such a violation does not trigger the waiver of privilege for documents and information that would have been responsive. *See* TBMP § 403.03. Such a sanction is certainly not applicable here, where Sprinkles complied with its discovery obligations and further provided materials upon meeting and conferring with counsel.

The TTAB has never imposed such a sanction. The TTAB has addressed the issue of privilege log in one case: *M.C.I. Foods, Inc. v. Brady Bunte*, 86 USPQ2d 1044 (February 19,

³ When detail for each document proved too burdensome, Sprinkles provided a category to documents with sufficient information to substantiate the privilege. Sprinkles used this approach to address documents withheld in response to Soft Serve’s request for all documents and information concerning “opinions of counsel” on the use and registration of the SPRINKLES marks. *See* Soft Serve’s Production Request No. 5 & Interrogatory No. 8. These requests arguably call for production of every communication between Sprinkles and outside counsel over the course of several years. In addition, the requests (for “opinions of counsel”) only implicates privileged materials. Given Soft Serve’s dogged pursuit of this paradigmatically privileged information, that it clearly does not have a right to discover, Sprinkles suspects that the requests were propounded merely to create an expensive discovery burden in the creation of a detailed privilege log for a voluminous set of obviously privileged materials. Fortunately, the law does not require parties to participate in such busy-work, and instead deems the identification of the category of documents – often including the senders and recipients, the date range, and the general subject matter – to be sufficient. *See Securities and Exchange Commission v. Thrasher*, 1996 WL 125661 (S.D.N.Y. 1996) (holding that a description of categories of documents is sufficient); *see also Securities and Exchange Commission v. Nacchio*, 2007 WL 219966 (D. Colo. 2007) (same). Sprinkles has provided this description.

2008). In *MCI Foods*, the Board ordered a party to provide privilege log only after the party had failed to respond to discovery, *and* only after the party failed to comply with a prior Board order to produce discovery. *See id.* at 1048. Even in these circumstances, the Board did not impose the exceedingly harsh sanction of waiver of privilege. Soft Serve's request to impose this sanction here – where Sprinkles did provide timely responses to discovery, did provide an immediate explanation for the basis of privilege claims, and did provide an official privilege log – is unprecedented and absurd.

In federal courts as well, waiver of privilege is a sanction only applied in egregious circumstances. In general, if a party has failed to provide a privilege log or other type of explanation of the basis for privilege, the court – like the Board in *M.C.I. Foods* – will simply order the party to provide a log. For example, in *Smith v. Café Asia*, 256 F.R.D. 247, 251 (D.D.C. 2009), a party requested waiver of privilege for another party, who had not provided a privilege log or any basis for claims of privilege nearly a year after a request for a privilege log. The *Smith* court rejected the request to impose the sanction, holding that the party's "discovery violation does not justify such a sanction." *See id.* Instead, the court merely ordered the party to provide a privilege log. *Id.* *See also TIG Insurance Co. v. Fireman's Insurance Co. of Washington DC*, 718 F. Supp. 2d 90, 97 (D.D.C. 2010) ("[T]he court generally does not deem a party to have waived a privilege because it did not provide an adequate privilege log.") (citing *Smith*); *Trustees of Electrical Workers Local No. 26 Pension Trust Fund v. Trust Fund Advisors*, 266 F. R.D. 1, 9 n.8 (D.D.C. 2010) ("[F]ailure to produce a privilege log does not justify the harsh sanction of privileged documents.") (citing *Smith*).

Soft Serve has not even asserted – let alone proven – any violation or bad faith on the part of Sprinkles that would justify this harsh remedy. The cases Soft Serve cites are older, and in any event do not contradict (or even deviate from) the strong consensus in the federal case law that waiver is only imposed as a sanction in extreme cases of bad faith, unjustified delay and inexcusable conduct. *See First American Corp. v. Al-Nahyan*, 2 F. Supp. 2d 58, 60 (D.D.C. 1998) (merely stating a general rule to provide a basis for privilege claims; the case concerned sealing of

criminal records under a New York statute); *Banks v. Office of the Senate Sergeant-At-Arms*, 222 F. R.D. 7, 20 (D.D.C. 2004) (holding that waiver sanction was not warranted); *Bregman v. D.C.*, 182 F.R.D. 352 (D.D.C. 1998) (finding waiver of privilege only when the party failed to present any indication of why documents withheld would qualify for privilege, and when the party had failed to comply with court orders).

For these reasons, Soft Serve's repeated, extreme, and unjustified requests for waiver of privilege must be denied.

B. Specific Requests

1. Requests in the Motion for which Opposer's Only Argument Concerns Privilege

The bulk of the specific requests in the Motion concern only the outlandish request for waiver of privilege. For the reasons discussed above, this argument must be rejected; as a result, all issues in the motion pertaining to the following requests will be resolved, as privilege is the only issue asserted:

- Production Request No. 1, for documents relating to the adoption of the SPRINKLES mark.
- Production Request No. 5, for opinions of counsel.
- Production Request No. 8, for documents which mention Opposer. Soft Serve also argues that the objection based on overbreadth is ill-founded, but no documents were withheld on this basis.
- Production Request No. 9, for documents related to search reports.
- Production Request No. 14, for documents evidencing Sprinkles' intent to use the SPRINKLES mark in connection with the goods in the application. Soft Serve also argues that the objection based on overbreadth is ill-founded, but no documents were withheld on this basis.

- Production Request No. 15, for documents showing the circumstances under which Sprinkles learned of Soft Serve.
- Production Request No. 18, for documents related to the relationship and dealings between Sprinkles and the previous owners of SPRINKLES PALM BEACH.
- Interrogatory No. 5, for information related to the relationship and dealings between Sprinkles and the previous owners of SPRINKLES PALM BEACH.
- Interrogatory No. 8, for opinions of counsel.

2. Remaining Requests Where There Is No Dispute

There are few issues remaining after the privilege issue is resolved. For most of the remaining issues, there is no dispute between the parties:

Production Request No. 4, for marketing plans. Sprinkles has responded to this request, and has notified Soft Serve that there are no responsive documents in its possession. Sprinkles has explained this response repeatedly, and has reiterated that there are no responsive document. Soft Serve does not present any reason or basis for its request to compel a response, as Sprinkles has already responded fully to the production request.

Production Request No. 7, for documents related to acquisition of the SPRINKLES PALM BEACH marks, and correspondence between Sprinkles and a third party regarding the SPRINKLES PALM BEACH marks. Sprinkles has produced all documents in its possession regarding the acquisition (as Opposer concedes, *see* Motion at 7), and has also produced all correspondence regarding Sprinkles' enforcement of the SPRINKLES PALM BEACH marks. The documents are at SC000104-SC000124. Soft Serve has not articulated a basis for believing that additional documents exist, beyond the vague innuendo that "it is believed that Applicant routinely asserts the SPRINKLES OF PALM BEACH marks and registrations as part of its practice in threatening third party users of SPRINKLES related marks." Motion at 7. Indeed Sprinkles is not aware of any additional documents in its possession that are responsive to this request. Sprinkles has not withheld any correspondence between Sprinkles and third parties regarding enforcement of

the SPRINKLES PALM BEACH marks. For these reasons, Soft Serve's request to compel documents is inadequate and moot.

Opposer also argues that privilege should be waived for this request, but for the reasons stated above such a request must be denied. To the extent there are any attorney-client communications regarding the acquisition or enforcement of the SPRINKLES PALM BEACH marks, such documents are protected from disclosure by the attorney-client privilege and have been identified properly in Sprinkles' correspondence and privilege log.

Production Request No. 10, for documents relating to challenges by third parties to Sprinkles' right to use or register SPRINKLES. Sprinkles has fully complied with this request. The documents are located at SC000104-SC000124.

Opposer also argues that privilege should be waived for this request, but for the reasons stated above such a request must be denied.

Production Request No. 11, for documents evidencing Sprinkles' first use of Sprinkles. Sprinkles has produced all documents related to this request. Sprinkles initially objected on the basis that publically available documents were equally available to Soft Serve, and explained this objection in its September 30 letter ("though documents may not be in Sprinkles' possession, they may be available in public databases or repositories. Such databases are equally available to Soft Serve as they are to Sprinkles." September 30 letter at 2. Sprinkles further directed Soft Serve to the Trademark Document Retrieval service at www.uspto.gov. *See id.* Though this objection was valid and appropriate, in a subsequent production on November 23, 2010, Sprinkles produced all file wrappers for the SPRINKLES-related applications, and all publically available news articles found through online, public archives and LEXIS and Westlaw news searches. Sprinkles also produced a full copy of its website in its first production to Soft Serve, even though that information was available to Soft Serve as well. There are no documents withheld on the basis that they are publically available and therefore equally available to Opposer, and therefore no documents to compel.

To the extent privileged documents could evidence Sprinkles' first use date, these documents were not produced. Soft Serve's request to impose waiver of privilege should be denied for the reasons discussed above.

Interrogatory No. 11, requesting information regarding the first use of Sprinkles' marks. Sprinkles responded fully with respect to its own use of the trademark in the initial responses, identifying the documents in the production which stated Sprinkles' first use in 2004. In addition, Sprinkles has produced additional documents as noted above, which provide and substantiate the information sought in the request. Even so, Sprinkles has also provided a supplemental response to this interrogatory, identifying the 1985 first use date for SPRINKLES OF PALM BEACH. *See* Hire Decl., ¶ 6.

Production Request No. 21, for documents related to the first use of SPRINKLES and SPRINKLES OF PALM BEACH. Sprinkles objected to this request to the extent it called for a legal conclusion; Soft Serve argues that this objection is unfounded. There can be no dispute that the term "first use" in the trademark context is a legal term of art, and that numerous cases, articles, and treatises are dedicated to the meaning of the term. Indeed, there are entire sections of the Trademark Manual of Examining Procedure devoted to the meaning of the term in the context of an application at the Patent and Trademark Office, *see, e.g.*, §§ 901 & 903, and full chapters in major trademark treatises dedicated to the type of use that constitutes "first use" for establishing priority of a trademark, *see, e.g.*, McCarthy on Trademarks and Unfair Competition, Chapter 16: Acquisition and Priority of Trademark Rights.

Regardless, Sprinkles has produced documents to demonstrate that its first use of the SPRINKLES mark for bakery goods in 2004, and that its rights in the SPRINKLES PALM BEACH mark date back to 1985. *See* SC000250-SC000255. Soft Serve, on the other hand, has produced no documents showing use in commerce of the SPRINKLES mark before 2005, and no documents showing contemplation of use before November 2002, even though it claims a first use date of April 2002.

Interrogatory No. 13, requesting parties against whom Sprinkles has asserted its trademark rights in the SPRINKLES and SPRINKLES OF PALM BEACH marks. Under the heading of Request for Production No. 22 (which Sprinkles addresses in Section III.B.3 below), Soft Serve raises an issue concerning Sprinkles' response to this Interrogatory. Sprinkles initially identified all the parties, as requested in the interrogatory. Though not requested in the interrogatory, Sprinkles has further provided a supplemental response identifying the marks at issue in each matter. *See* Hire Decl., ¶ 6. Therefore, Sprinkles has addressed all concerns raised in the Motion pertaining to this Interrogatory.

Production Request No. 25, requesting documents sufficient to show continuity of usage of the SPRINKLES OF PALM BEACH marks. Soft Serve takes issue with Sprinkles' objection to the vague and ambiguous term "continuity of use." This objection is well founded, as the term is unclear: Is Soft Serve requesting documents submitted to the PTO to establish that Applicant's use has been continuous to satisfy filings under Sections 8 & 15? Is Soft Serve requesting news articles from the 1990s through 2010 demonstrating that Sprinkles and its licensee (and predecessor in interest) have used the SPRINKLES OF PALM BEACH marks over time, and still use the marks? In any event, Sprinkles has produced documents sufficient to satisfy either meaning of the request, as it has produced the entire file wrapper for the SPRINKLES OF PALM BEACH marks, including the Section 8 & 15 filings, as well as relevant articles demonstrating use of the marks over time.

For these reasons, Soft Serve's motion concerning these Requests and Interrogatories should be denied.

3. Requests Where There Is a Dispute

After dispensing with the privilege issue and the Requests and Interrogatories where there is no dispute between the parties (as there are no further documents or information to disclose), there are only four remaining requests:

Production Request No. 2 & 3, for samples of each different use of the mark, and for materials relating to advertising or promotion, respectively. Sprinkles responded to these requests,

and produced numerous documents showing use of the SPRINKLES mark on packaging, on signage, and on other products (i.e., water bottles). Sprinkles further provided a full copy of its website, and other marketing materials as well. These documents are representative of Sprinkles' use of the mark, and of its advertising and marketing efforts. To produce all documents *related to* marketing the SPRINKLES mark would be highly burdensome, as Sprinkles has engaged in widespread promotion efforts and has received an enormous amount of media attention. In such cases, production of a representative sampling of documents is commonplace and acceptable. *See* TMBP § 402.02 ("For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought."). Advertising material is the paradigmatic example of the category of documents for which a representative sampling is appropriate. *See Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowing a representative sampling of advertising material) (*cited in* TBMP § 402.02, n. 14).

Sprinkles has produced hundreds of pages of documents to comprise a representative sampling of use and advertising material. Soft Serve does not articulate why the representative sampling here is not satisfactory, nor does it explain what advantage additional documents would convey. Indeed, the only effect of a full production would be to unduly burden Sprinkles. Soft Serve's Motion should be denied with respect to Production Requests 2 and 3.

Production Request No. 22, for documents related to conflicts, challenges and controversies with third parties involving Sprinkles' marks. As mentioned above, in its response to Interrogatory No. 13, Sprinkles has provided information concerning the identities of the parties with whom it has addressed inappropriate use of the SPRINKLES mark. Sprinkles has also supplemented its responses to provide information regarding the trademarks involved in each dispute.

The demand letters and other correspondence between Sprinkles and these parties is irrelevant, and not likely to lead to the discovery of admissible evidence. Soft Serve has presented no reason or justification for why this information would be necessary to pursue its claims in this

action. Indeed, there is no reason. For this reason, Soft Serve's Motion to compel further documents pursuant this request should be denied.

Interrogatory No. 4, for revenues of Sprinkles and its licensee. This request is similarly irrelevant and not likely to lead to the discovery of admissible evidence. Like all TTAB proceedings, this action solely concerns the registration of the mark. The Board does not issue damages, or any other kind of monetary relief. *See* TBMP § 502.05 ("The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party."); *see also Babson Bros. Co. v. Surge Power Corp.*, 39 U.S.P.Q.2d 1953, 1954 (TTAB 1996) ("[T]he Board cannot enjoin a party from using a mark, nor can it award monetary damages.") (superseded on other grounds). There is no relationship between Sprinkles' revenues and the registrability of this SPRINKLES trademark. With respect to Sprinkles' licensee's revenues, in addition to being irrelevant to this proceeding, the information is also outside of Sprinkles' possession, custody, or control.

Soft Serve again has presented no reason for its request, and no basis for the relevance of this information. In contrast, the information is highly commercially sensitive, and Sprinkles is understandably uncomfortable with the release of such information even with the Protective Order in place. For these reasons, Soft Serve's Motion to compel this information should also be denied.

IV. CONCLUSION

For the reasons stated above, Sprinkles requests that Soft Serve's Motion to Compel be dismissed in its entirety.

Dated: January 14, 2011

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /s/ Hollis Beth Hire
John L. Slafsky
Hollis Beth Hire

Attorneys for Applicant
Sprinkles Cupcakes, Inc.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Soft Serve, Inc. d/b/a Sprinkles,

Opposer,

v.

Sprinkles Cupcakes, Inc.,

Applicant.

Opposition No: 91194188

DECLARATION OF HOLLIS BETH HIRE

1. I am an attorney at Wilson Sonsini Goodrich & Rosati, counsel for applicant Sprinkles Cupcakes Inc. ("Sprinkles") in this matter. I have personal knowledge of the facts set forth in this declaration.

2. Several months ago, Thomas Vande Sande, counsel for Opposer Soft Serve, Inc. ("Soft Serve"), requested that all discovery in one action be available for use in the other Sprinkles-related actions pending before the Trademark Trial and Appeal Board. After clarifying the request, Sprinkles agreed to this arrangement. On December 27, 2010, I contacted Mr. Vande Sande to ask whether Soft Serve would consent to a motion to suspend all proceedings pending the disposition of the motion to compel, and I have followed up on the request by email. This week, Mr. Vande Sande responded to my email, and reported that he would let me know in the next few days.

3. Attached as Exhibit 1 are true and correct copies of correspondence from my office transmitting nearly 2000 pages of documents to counsel for Soft Serve.

4. Attached as Exhibit 2 are true and correct copies of Sprinkles' redaction and privilege logs provided to counsel for Soft Serve on December 30, 2010.

5. Though Soft Serve objected on privilege grounds to multiple discovery demands, and though Sprinkles requested a privilege log in September, Soft Serve has not provided a privilege log to Sprinkles.

6. On January 13, 2011, Sprinkles served additional supplemental discovery, supplementing the responses to Interrogatories 11 and 13. The supplemental response to Interrogatory No. 11 identified the 1985 first use date for SPRINKLES OF PALM BEACH. The supplemental response to Interrogatory 13 included all the marks at issue in the disputes listed.

I declare under penalty of perjury that the foregoing is true and correct. Executed at Oakland, California, on January 14, 2011.

/s/ Hollis Beth Hire
Hollis Beth Hire

EXHIBIT 1

July 9, 2010

VIA OVERNIGHT COURIER

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
Potomac, MD 20854

**Re: Soft Serve v. Sprinkles – Opposition No. 91194188 (Trademark Trial and
Appeal Board)**

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC000001 – SC000935. Please note that some of the documents are designated "Confidential" or "Trade Secret/Commercially Sensitive" pursuant to the Stipulated Protective Order approved by the Board on July 2, 2010. The enclosed documents must be treated as specified by the Protective Order.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation


Matthew J. Kuykendall

Enclosures

November 23, 2010

VIA U.S. MAIL

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
Potomac, MD 20854

Re: Soft Serve v. Sprinkles – Opposition No. 91194188 (Trademark Trial and Appeal Board)

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC000936 – SC001690. Please do not hesitate to call if you have any questions.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation



Hollis Beth Hire

Enclosures

December 28, 2010

VIA U.S. MAIL

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
Potomac, MD 20854

**Re: Soft Serve v. Sprinkles – Opposition No. 91194188
(Trademark Trial and Appeal Board)**

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC001691 - SC001913. Please do not hesitate to call if you have any questions.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation


Hollis Beth Hire

Enclosures

EXHIBIT 2

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.**Opposition No. 91194188****Redaction Log for 7/9/10 Production by Sprinkles Cupcakes, Inc.**

SC000006	Email from B. Nelson to Charles re: palm beach daily news claims 1983 in fire article	Email communication from C. Nelson to J. Slafsky on 3/29/2010 protected by attorney-client privilege
SC000239	Email from D. Marks to B. Nelson re: fedex label for samples	Email communication from B. Nelson to J. Slafsky on 6/14/2010 protected by attorney-client privilege
SC000278	Email from B. Nelson to C. Nelson re: Palm beach -- privileged/confidential	Email communication from C. Nelson to J. Slafsky on 7/20/2009 protected by attorney-client privilege
SC000286	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Invoice from Dr. Bob's of Upland	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000288	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000290	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000292	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000293	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Invoice from Dr. Bob's of Upland	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000295	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Report from Dr. Bob's Handcrafted Ice Creams	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000297	Email from A. Lenardin to Charles re Ice cream packaging	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Redaction Log for 7/9/10 Production by Sprinkles Cupcakes, Inc.

SC000300	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine
SC000658	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine
SC000659	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Applicant Sprinkles Privilege Log

December 29, 2010

Date	To	From	Subject	Privilege Claim
7/15/2005	Charles Nelson	John Slafsky	Attorney advice regarding availability search for SPRINKLES mark	Attorney-client privilege
2/23/2009	Charles Nelson	Hollis Hire	Attorney advice regarding availability search for SPRINKLES mark	Attorney-client privilege
3/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
3/29/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/1/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/3/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/6/2010	Bobby Nelson & Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/1/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/7/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/10/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/16/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/17/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/24/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/27/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Matthew Kuykendall	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Matthew Kuykendall	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Charles Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege

Soft Serve, Inc. d/b/a Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Applicant Sprinkles Privilege Log

December 29, 2010

Date	To	From	Subject	Privilege Claim
7/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
7/7/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
7/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
8/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Matthew Kuykendall & Bobby Nelson	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
8/30/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/4/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/5/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/7/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/12/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/25/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/28/2010	John Slafsky & Hollis Hire	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
10/29/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/1/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/8/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/23/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/30/2010	Charles Nelson	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
12/1/2010	John Slafsky	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
12/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
2005-2010	Charles Nelson, Nicole Schwartz, & Bobby Nelson	John Slafsky, Hollis Hire, Matthew Kuykendall, and other attorneys at Wilson, Sonsini, Goodrich & Rosati	Opinions of outside counsel regarding Sprinkles' right to use or register SPRINKLES	Attorney-client privilege & work product doctrine

CERTIFICATE OF SERVICE BY MAIL

I, Jo Ann Hylton, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

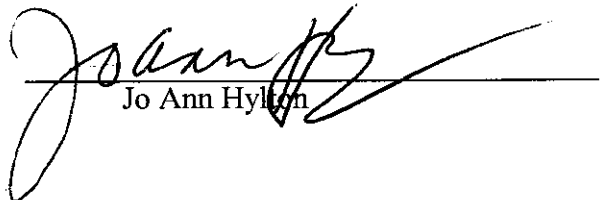
On this date, I served:

- 1. APPLICANT SPRINKLES CUPCAKES' OPPOSITION TO OPPOSER'S MOTION TO COMPEL**
- 2. DECLARATION OF HOLLIS BETH HIRE**

on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
Potomac, Maryland 20854

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on January 14, 2011.


Jo Ann Hylton